

Remarks

Claims 1-26 are pending in the application. Claims 1, 4, 17, 22 and 23 are amended. The rejections of Claims 1-26 are respectfully traversed below.

A. Claims 1, 3, 6 and 11 Are Novel

Claims 1, 3, 6, and 11 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,223,445 to **Schuette**. Claim 1 has been amended to include the limitations: “(b) a handle on the plate in a first location; and (b) a first level on the plate in a second location” Accordingly, independent claim 1 and dependent claims 3, 6 and 11 now recite a tool comprising a plate with a handle and a level that are positioned at different locations on the plate. A first location of a handle (16, 46, or 66) on a plate (12, 42, or 62) and a second location of a level (17, 18, 47, or 67) on the plate (12, 42, or 62) are shown in Figures 1, 4, 5, 6, 8 and 10a of the application.

Schuette, on the other hand, describes a remodel box installation tool having an elongated level indicator (64) mounted to a surface (58) of a base (52) by support means (65). Claim 1 of **Schuette** states that “the elongated level indicator serves as a gripping handle to support the template tool....” Because the level (64) and “handle” of **Schuette** are a single member, the level cannot be at a first location on a plate while the “handle” is at a second location on the plate as claimed. Therefore, **Schuette** does not anticipate Claim 1, 3, 6 or 11 because **Schuette** does not disclose every element recited in independent Claim 1. Accordingly, the rejections of claims 1, 3, 6 and 11 should be withdrawn.

B. Claims 2, 4, 5, 7-10, and 12-26 are Not Unpatentable As the Office Action Has Not Made Out a Prima Facie Case of Obviousness

The Examiner has the burden to establish a prima facie case of obviousness when rejecting claims under 35 U.S.C. §103(a). See MPEP 2142. To establish a prima facie case of

obviousness, three basic criteria must be met. *See* MPEP 2143. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *See Id.* Indeed, the proposed modification cannot render the prior art unsatisfactory for its intended purpose and cannot change the principle of operation of a reference. *See* MPEP 2143.01. Second, there must be a reasonable expectation of success. *See* MPEP 2143. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See Id.* The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *See Id.* (citing *In re Vaeck*, 947 F.2d 488, 20USPQ2d 1438 (Fed. Cir. 1991)).

1. Claims 2, 4, 5 and 7 are Patentable Over Schuette in View White

Claims 2, 4, 5, and 7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 2,998,655 to **White**. The Office action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use plural levels as taught by **White** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device in a plurality of orientations.” The Office Action further states it would also have been obvious “to use graduations as taught by **White** in conjunction with the **Schuette** device to permit a person to make measurements with the **Schuette** device.”

Claims 2, 4, 5, and 7 depend from amended Claim 1, and therefore include every limitation of Claim 1. As discussed above regarding claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **White** and **Schuette** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 2, 4, 5 and 7. Accordingly, the rejection of claims 2, 4, 5 and 7 should be withdrawn. Furthermore, because remodel boxes always are oriented the same way on a vertical wall, the remodel box installation tool described in **Schuette** always is used in a single, upright orientation. Therefore, **Schuette** actually teaches away from a

marking tool or template that is used in more than one orientation. Accordingly, there is no suggestion in **Schuette** “to use plural levels as taught by **White** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device in a plurality of orientations.” Still further, the **Schuette** device requires no form of measurement to mark a remodel box opening on a wall. Accordingly, there is no suggestion in **Schuette** to add graduations “to permit a person to make measurements with the **Schuette** device.” The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

2. Claims 8-10 and 22-26 are Patentable Over Schuette in View of Barr

Claims 8-10 and 22-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 6,226,882 to **Barr**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use marking materials as taught by **Barr** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device to print patterns on a surface.”

Claims 8-10 depend from amended Claim 1, and therefore include every limitation of Claim 1. As discussed above regarding claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Barr** and **Schuette** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 8-10, and the rejection of claims 8-10 should be withdrawn.

Independent claims 22 and 23 have been amended to recite a handle on the panel in a first location and at least one spirit level on the tool in a second location. Claims 24-26 depend from claim 23, and therefore also include these limitations. As discussed above regarding claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed

combination of **Barr** and **Schuette** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 22-26. In addition, claim 23 has been amended to recite a method of painting that includes “painting a pattern on the substantially vertical surface using the marked shapes as a guide.” None of the cited references disclose such a painting step. Accordingly, the rejection of claims 22-26 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the reference for the proposed modification to **Schuette** in view of **Barr**. Specifically, there is no teaching or suggestion in **Schuette** to use the marking materials as taught by **Barr** in conjunction with the **Schuette** device. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

3. Claim 12 is Patentable over Schuette in View of Johansen

Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 5,864,959 to **Johansen** et al. The Office Action states that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a concave surface as taught by **Johansen** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device to print patterns on a surface.”

Claim 12 depends from amended Claim 1, and therefore includes every limitation of Claim 1. As discussed above regarding Claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Schuette** and **Johansen** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claim 12, and the rejection of claim 12 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** in view of **Johansen**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

4. Claims 13 and 14 are Patentable Over Schuette in View of Trane

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 1,614,812 to **Trane** et al. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the handle as taught by **Trane** in conjunction with the **Schuette** device as an alternative means for holding the **Schuette** device.” The Applicant respectfully traverses this rejection.

Claims 13 and 14 depend from Claim 1, and therefore include every limitation of claim 1. As discussed above regarding Claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Schuette** and **Trane** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 13 and 14, and the rejection of claims 13 and 14 should be withdrawn.

Furthermore, **Trane** does not disclose a handle “wherein the handle is a knob that is sized and configured for grasping in the palm of a person’s hand” as recited in claim 13, or such a knob that “includes at least one contoured recess sized and shaped to receive at least one finger of a person’s hand when the knob is grasped in the palm of the person’s hand” as recited in claim 14. As described in the Applicant’s specification:

A handle 16 is attached to the outer face 19 of the plate 12. In the embodiment shown, the handle 16 is a substantially round knob that is sized and configured to

be gripped in the palm of a person's hand. The handle 16 may have any shape that is suitable for gripping in a person's hand or fingers. For example, the handle 16 may include a series of grooves or contours that cause the handle 16 to closely conform to a person's hand and/or fingers. (Page 4, lines 2-7)

Though the ruler shown in Figures 1-5 of **Trane** includes a "ring" (15), this ring (15) is described as a "pressure member" that is "operated by a finger of the operator." (Column 1, lines 41-48) Accordingly, the ring (15) described by **Trane** is not sized and shaped for grasping in the palm of a person's hand as claimed in Claims 13 and 14. Nor does the ring (15) of **Trane** include a contoured finger recess as recited in Claim 14. Accordingly, even if the proposed combination of **Schuette** and **Trane** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 13 and 14, and the rejection of claims 13 and 14 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** in view of **Trane**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

5. Claims 15 and 16 are Patentable over Schuette in View of Greer

Claims 15 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. patent No. 6,195,904 **Greer**. The Office Action states "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the plates as taught by **Greer** in conjunction with the **Schuette** device for the purpose of rendering the **Schuette** device more versatile and adjustable." The Applicant respectfully traverses this rejection.

Claim 15 and 16 depend from independent claim 1. As discussed above regarding Claim 1, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Schuette** and **Greer** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 15 and 16, and the rejection of claims 15 and 16 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** in view of **Greer**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

6. Claims 17-19 are Patentable over Schuette in View of Innis

Claims 17-19 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of U.S. Patent No. 6,349,823 to **Innis**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the instructions as taught by **Innis** in conjunction with the **Schuette** device to provide instructions for how to use the **Schuette** device.” The Applicant respectfully traverses this rejection.

Similar to Claim 1 as discussed above, independent claim 17 has been amended to recite “a handle on the plate in a first location” and “a level attached on the plate in a second location.” Claims 18 and 19 depend from Claim 17, and therefore include the same limitations. Again, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Schuette** and **Innis** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 17-19, and the rejection of claims 17-19 should be withdrawn.

Regarding Claim 19, neither **Schuette** nor **Innis** disclose “at least one paint product” as claimed. Even if the proposed combination of **Schuette** and **Innis** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claim 19, and the rejection of claim 19 should be withdrawn.

Furthermore, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** in view of **Innis**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

**7. Claims 20 and 21 are Patentable over Schuette in View of Innis,
and Further in View of Barr**

Claims 20 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over **Schuette** in view of **Innis**, and further in view of **Barr**. The Office Action states “it would have been obvious to one of ordinary skill in the art at the time the invention was made to use marking materials as taught by **Barr** in conjunction with the **Schuette** device for the purpose of using the **Schuette** device to print patterns on a surface.” The Applicant respectfully traverses this rejection.

Claim 20 and 21 depend from independent claim 17. As discussed above regarding Claim 17, **Schuette** does not disclose, and actually teaches away from, a tool having a handle on a plate in a first location and a level on the plate in a second location. Accordingly, even if the proposed combination of **Schuette**, **Innis** and **Barr** is proper (which the Applicant does not hereby admit), the modification to **Schuette** does not include every element recited in claims 20 and 21, and the rejection of claims 20 and 21 should be withdrawn.

In addition, the Office Action does not identify any teaching or suggestion in the references for the proposed modification to **Schuette** in view of **Innis**, and further in view of

Barr. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. Absent such a teaching or suggestion, the rejection is improper, and should be withdrawn.

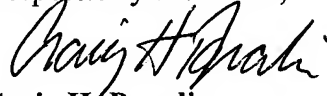
C. Claim 4 is Amended to Correct Matters of Form

Claim 4 has been amended to correct matters of form only. The word --a-- has been inserted before the word “first.”

Conclusion

Applicant believes this case is now in condition for the immediate allowance of Claims 1-26, and such action is respectfully requested. If any issue remains unresolved, however, Applicant's attorney welcomes the opportunity for a telephone interview to expedite allowance and issue.

Respectfully submitted,



Craig H. Popalis
Registration No. 49,028

Womble, Carlyle, Sandridge, & Rice PLLC
P.O. Box 7037
Atlanta, GA 30357-0037
(336) 574-8099

Date: 7/29/04

File No.: C49278.0001.8